

PTO/SB/08a and pray the Examiner will consider the references cited in the IDS filed three and half years ago.

Claim Rejections - 35 U.S.C. §§102

Claims 1-8 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The Office Action states that United States Patent Number 7,217,899 to Hidaka et al. (Hidaka) discloses the invention claimed in the instant application. The Office Action further states that at the instant, because the instant application and Hidaka **disclose** the same invention, it is unclear to the Examiner who in fact the inventor of the invention recited by the pending claims of the instant application is/are since the instant application and Hidaka share common inventors, but different Assignees. As such, the Examiner is requiring proof of inventorship of the invention recited by the pending claims.

Applicants respectfully submit that the basis of the rejection is factually erroneous and appears to indicate a lack of understanding of basic principles of the United States patent system for at least the following reasons.

1. Applicants note the instant application claims priority from the June 20, 2003 filing date of Japanese Patent Application Number 2003-176015 and the September 26, 2003 filing date of Japanese Patent Application Number 2003-335432. The Office Action dated October 16, 2008 indicates the Patent Office has received certified copies of the priority documents.

To perfect the claim for priority, Applicants enclose herein a verified translation of the Japanese priority documents, thereby perfecting Applicants claim for priority.

In view of the above, Applicant submits the effective date of the instant application is, at the latest, **September 26, 2003**.

Applicants respectfully submit that Hidaka is **not** prior art. In particular, Applicants note that Hidaka was filed in the U.S. Patent Office on March 8, 2005. Therefore, the effective filing date of Hidaka, which is its U.S. filing date, is **March 8, 2005**. Hence, the effective filing date of Hidaka is nearly eighteen month (or 1.5 years) **after** the effective date of the instant application and Hidaka is therefore **not** prior art.

2. Applicants fulfilled the requirements of proving who the inventors of the claimed invention recited by the instant are by submitting an Oath/Declaration with the application on **December 8, 2005**.

3. Applicants remind the Examiner that the Oath/Declaration avers as to the inventorship of the claimed invention. Hidaka, which is **not** prior art by at least 18 months relative to the invention recited by the pending claims, may disclose that which is recited by the pending claims, but patentability under the United States patent system is based on what is **claimed** and not what is **disclosed**. Applicants submit Hidaka may disclose that which is claimed by the instant application, but Hidaka does not **claim** that which is recited by the pending claims. Furthermore, Applicants remind the Examiner that Hidaka is not prior art.

For all of the reasons provided above, Applicants respectfully submit the rejection should be withdrawn.

Claim Rejections - 35 U.S.C. §§102/103

A. Claims 1-6 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,075,294 to Van den Boom et al. (Van den Boom) in view of U.S. Patent No. 5,304,967 to Hayashi and U.S. Patent No. 6,740,834 to Sueyoshi et al. ('834).

Applicants respectfully traverse the rejection for the same reasons articulated in the Preliminary Amendment filed on January 16, 2009.

To recap that which was argued in the January 16 Preliminary Amendment, Claim 1 recites a vehicle door outer handle system including, among other features, a pair of electrodes patterned on a circuit board and a ground plate housed within an operating handle, wherein the electrodes are covered by the ground plate and ***a covering made of a synthetic resin covers the ground plate and is disposed between the ground plate and the electrodes***. See Figures 2-6 and 8 for exemplary illustrations of the synthetic resin covering the ground plate as well as being disposed between the ground plate and the electrodes. As explained at least on page 10, lines 18-24 of the application as originally filed, the claimed invention provides the benefit of the circuit board and electrodes being easily assembled within the operating handle and improves the water resistance of the circuit board and electrodes.

A key feature distinguishing the claimed invention from the art of record is the structural feature of a covering made of synthetic resin not only covers the ground plate, but is also disposed ***between*** the ground plate and the electrodes. Applicants direct the Examiner's attention to Figure 3, which illustrates an exemplary embodiment of the recited feature in question. In particular, see the resin covering portion 48 and how the

component not only covers the ground plate 47, but is also disposed between the ground plate 47 and the electrodes 43 patterned on the circuit board 44.

As articulated by the Applicants in the January 16 Preliminary Amendment, Van den Boom, at column 4, lines 43-45 and in Figure 4, teaches the electrodes 30, 33 and circuit 34 are coated with a layer of insulating material 36, i.e., the ground plate (as characterized by the previous Office Action), to seal the electrodes 30, 33 and circuit 34 off from air. That is, Van den Boom expressly teaches that the ground plate or insulating material 36 is applied directly to the electrodes 30, 33 and circuit 34 to seal the components off from air. In other words, Van Den Boom teaches a structural arrangement of components that prevents or prohibits **anything** from being positioned between the ground plate or insulating material 36 and the electrodes 30, 33 and circuit 34 so as to seal the components off from air. Therefore, not only does Van den Boom not teach or suggest another component being disposed between the ground plate or insulating material 36 and the electrodes 30, 33 and circuit 34, such as a covering portion made of synthetic resin, but Van den Boom specifically teaches away from disposing another component therebetween in order to seal the electrodes 30, 33 and circuit 34 off from outside elements.

Ignoring the express teachings of Van den Boom, the outstanding Office Action now asserts a rejection that is predicated on the notion that Sueyoshi '834 teaches it is well known in the art to use a potting material to cover certain electronic elements. As such, the Office Action asserts it would be obvious to one of ordinary skill in the art to encapsulate the ground plate 36 and electronics 30, 33 and 34 taught by Van den Boom with the resin material 110 taught by Suyoshi '834 to provide protection to the members.

Applicants respectfully submit that the basis of the rejection is based on unacceptable hindsight reasoning, completely ignores that which is expressly taught by Van den Boom, and still does not arrive at the invention recited by Claim 1.

Van den Boom already teaches an insulating material that is the ground plate 36 and which covers the electrodes 30, 33 and circuit 34, thereby sealing off the elements from outside elements.

The Office Action now argues it would be obvious to one of ordinary skill in the art to encapsulate or cover the electrodes, 30, 33, circuit 34 and ground plate/insulating material 36 with yet another resin layer 110, as taught by Sueyoshi '834, for supposedly protecting the elements 30, 33, 34 and 36, including the protective element, that is, the insulating material/ground plate 36 with yet another resin/insulating layer 110 from Sueyoshi '834. Applicants respectfully submit such logic, if one can call it such, can only be arrived at by hindsight reasoning as one of ordinary skill in the art would not easily arrive at the conclusion asserted by the Office Action, that is, it would be obvious to cover one protective layer with another when the first protective layer is sufficient to achieve the objective supposedly provided by the second protective layer.

Moreover, Applicants remind the Examiner that Claim 1 recites the covering made of synthetic resin not only must cover the ground plate, but also must be disposed **between** the ground plate and the electrodes. As such, Applicants respectfully submit that applying the resin coating 110 taught by Sueyoshi '834 onto or even around the ground plate or insulating material 36 taught by Van den Boom would still not result in the invention recited by the pending claims since the Sueyoshi '834 resin must still be disposed or located **between** the ground plate or insulating material 36 and the

electrodes 30, 33 and circuit 34, especially since Van den Boom specifically teaches **nothing** is to be provided between the ground plate or insulating material 36 and the electrodes 30, 33 and circuit 34.

Hayashi fails to cure or otherwise overcome the above-described deficiencies of Van den Boom as Hayashi merely teaches that it is well known in the art to provide a circuit board with electrodes patterned on it.

Accordingly, Applicants respectfully submit that Claim 1 is not rendered obvious in view of the teachings of Van den Boom, Hayashi, and Sueyoshi '834, alone or in any combination thereof, as one of ordinary skill in the art would not consider combining their respective teaches obvious, let alone practical in view of their express teachings.

Claims 2-8 depend from Claim 1. It is respectfully submitted that these dependent claims be deemed allowable for at least the same reason(s) Claim 1 is allowable, as well as for the additional subject matter recited therein.

Withdrawal of the rejection is respectfully requested.

B. Claims 1-6 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,883,840 to Sueyoshi et al. ('840) in view of Van den Boom, Hayashi, and Sueyoshi '834.

Applicants respectfully traverse the rejection for the following reasons.

As admitted by the Office Action, Sueyoshi '840 fails to teach a pair of electrodes, a handle having a main body and a cover, electrodes patterned on a circuit board, a ground plate and wherein the missing electrodes are covered by a covering portion made of a synthetic resin.

As far as Applicants can fathom, Sueyoshi '840, as the primary reference, is being cited for teaching a vehicle door system having a handle with a main body made of resin.

All of the remaining features recited by Claim 1, which the Office Action admits are not taught or suggested by Sueyoshi '840, are taught by Van den Boom, Hayashi and Sueyoshi '834.

Applicants respectfully submit that one of ordinary skill in the art would not find it obvious to modify Sueyoshi '840 according to the teachings of Van den Boom, Hayashi and Sueyoshi '840 for exactly the same reasons Applicants articulated in their remarks/arguments traversing rejection A. above, which are incorporated herein in their entirety.

Accordingly, Applicants respectfully submit that Claim 1 is not rendered obvious in view of the teachings of Van den Boom, Hayashi, and Sueyoshi '834, alone or in any combination thereof, as one of ordinary skill in the art would not consider combining their respective teaches obvious, let alone practical in view of their express teachings.

Claims 2-8 depend from Claim 1. It is respectfully submitted that these dependent claims be deemed allowable for at least the same reason(s) Claim 1 is allowable, as well as for the additional subject matter recited therein.

Withdrawal of the rejection is respectfully requested.

C. Claims 7-8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Van den Boom in view of Hayashi and '834, as applied to Claims 4 and 5, and further in view of U.S. Patent No. 6,769,154 to Klein et al. (Klein); and Claims 7-8 and rejected under 35 U.S.C. §103(a) as being unpatentable over '840 in view of Van den Boom, Hayashi, and '834 as applied to Claims 4 and 5, and further in view of Klein.

Claims 7-8 depend from Claim 1, which is discussed above. As such, in addition to the feature(s) recited by Claim 7-8, Applicants note Claims 7-8 include all of the features recited by Claim 1.

Sueyoshi '834, Sueyoshi '840, Van den Boom and Hayashi are discussed above.

Klein is cited merely for teaching that it is known to provide a holder that holds electrical components within a handle main body. As such, Applicants respectfully submit that Klein does not cure or otherwise address the above described deficiencies in Van den Boom, Sueyoshi and Hayashi.

Applicants respectfully submit Claims 7-8 depend from Claim 1, which is allowable for the reasons articulated above in items **A** and **B**. As such, Applicants respectfully submit that Claims 7-8 should be deemed allowable for at least the same reasons Claim 1 is allowable, as well as for the additional features recited therein.

Withdrawal of the rejections is respectfully requested.


Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of the application, withdrawal of the outstanding rejections, allowance of Claims 1-8, and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing attorney docket number 107348.00543.**

Respectfully submitted,



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Verified English translations of JP2003-176015 and JP 2003-335432